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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:) A POWER TRANSMISSION BELT
) HAVING A MARK THEREON AND A
SOKICHI NOSAKA ET AL) METHOD OF PROVIDING A MARK ON
) A POWER TRANSMISSION BELT
Ser. No.: 09/772,137)
) Examiner: Marcus Charles
Filed: 1/29/01) Art Unit: 3682

APPELLANT'S REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

This is a reply to the Examiner's Answer mailed on July 31, 2007. In the Examiner's Answer, new grounds of rejection are set forth for each of the appealed claims.


New Grounds of Rejection to be Reviewed on Appeal

Ground No. 1

The rejection of claims 4-7, 9-20 and 40 as obvious under 35 USC §103 over Japanese Patent Publication No. 10252833 (Japan '833) in view of U.S. Patent No. 6,103,349 (Matsumoto).

37 CFR 1.8
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 8-16-07 (date).


Terri Craine

Ground No. 2

The rejection of claims 38, 39 and 41 as obvious under 35 USC §103 over Matsumoto in view of Japan '833.

Argument - Ground No. 1

Claim 1

Japan '833, Appellant's own patent, discloses marking on only a "belt back face" that is used as a "driving surface". The Examiner acknowledges that Japan '833 does not disclose any marking on a lateral side surface of a belt body as claimed.

As pointed out in the Appellant's Brief on Appeal at page 8 (paragraph 1), the disclosure in Japan '833 is consistent with the Appellant's, and the industry's, earlier belief that the side surfaces of power transmission belts should not be structurally altered, as by inscription, lest there be a compromise in the structural integrity and/or performance of the belt.

The only prior art that the Examiner cites for the disclosure of marking on a belt side surface is Matsumoto. Consistent with the Appellant's, and the industry's, earlier concern about structurally altering belt side surfaces, Matsumoto teaches the application of a mark on a belt side surface through a hiding layer 4 that is applied to the belt. By reason of being an addition to the side surface, the hiding layer 4 does not structurally alter the belt side surface, as specifically required in Appellant's claims¹.

¹ While it is noted in paragraph 3 on page 8 of Appellant's Brief that Matsumoto also describes direct application of a mark to the belt side surface, there is no disclosure that would lead one to inscribe, or otherwise structurally alter, the belt side surface to apply the mark in this manner.

The U.S. Supreme Court in *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) maintained the Federal Circuit's holding in *In re Kahn*, quoting specifically therefrom that:

[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

The Supreme Court further stated:

Often it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community are present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, **all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.** (Our emphasis - Slip Opinion at page 14).

It is respectfully submitted that the Examiner has made merely a conclusion, repeated in paragraphs 2, 3 and 4 of the Examiner's Answer, that it would be obvious to combine the cited prior art, but has not stated **any** reason to combine the elements in the prior art to arrive at those recited in claim 1.

There are two additional problems with the Examiner's proposed combination. First of all, Japan '833 is concerned with inscription of a belt, whereas Matsumoto is concerned with using a hiding layer for mark application through other than inscription. These are two very different manners of applying marks on different parts of a belt. Appellant respectfully submits that it would not be obvious to simply ignore Matsumoto's teachings of mark application in a manner whereby there is not belt alteration, other than by addition, and to inscribe a mark on the belt side surfaces based on the teachings in Japan '833.

Secondly, claim 1 specifically requires inscription on at least one of the portions of at least one of the laterally spaced side surfaces that engages a cooperating pulley. Appellant's Brief on Appeal explains on pages 6 and 7 that Matsumoto teaches unequivocally that the mark is not to be applied on a surface that contacts a pulley during operation.

Thus, combining the teachings in Japan '833 and Matsumoto in a logical manner, and without having Appellant's claimed invention available as a template, one would not arrive at the structure recited in claim 1.

Claims 4-7, 10-14 and 18-20

The arguments advanced with respect to claims 4-7, 10-14 and 18-20 in Appellant's Opening Brief apply equally with respect to the new rejection.

Claims 9 and 15-17

The Examiner relies upon Japan '833 without Andrews in rejecting claims 9 and 15-17. Since the cited prior art does not teach or make obvious the formation of a depression in a belt side surface, the filling of such an inscribed depression by a contrasting material would not be obvious either.

Claim 40

The arguments advanced relative to the allowability of claim 1 apply equally to claim 40, with the exception that claim 40 does not require the inscription of a side surface portion that directly engages a cooperating pulley.

Appellant additionally notes that the teaching of inscription to a depth of 0.1 to 1 mm is not logically translated from Japan '833 to Matsumoto. In Japan '833, the depth relates to an exposed cloth layer on the back side of the belt. Inscription on the side surfaces results in the alteration of potentially all of the belt component layers on an edge thereof. While Appellant has found through experimentation that the range of 0.1 to 1 mm depth is in fact preferred for the belt side surfaces, Appellant respectfully submits it would not be obvious to assume that an inscription depth through a cloth layer on a flat drive surface would be equally appropriate on the edge portions of multiple layers.

Argument - Ground No. 2

Claims 38, 39 and 41

The new ground of rejection for these claims eliminates any reliance upon Andrews. The different depth considerations for inscription on the back side surface and pulley engaging side surfaces is set forth in the arguments relating to claim 40, above. The remaining arguments for patentability with respect to claims 38, 39 and 41, advanced in Appellant's Brief on Appeal, apply equally to the claims as newly rejected.

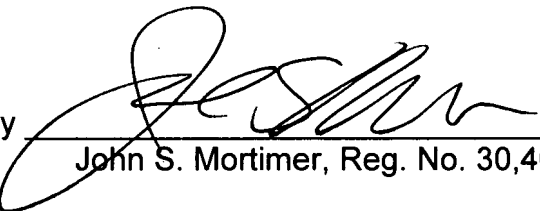
Conclusion

The art relied upon by the Examiner does not, collectively, teach or make obvious any alteration through depression-forming inscription of a belt side surface. In fact, the two pieces of prior art cited by the Examiner teach two very different ways of marking: a) Japan '833 by inscription on a back side surface of a belt; and b) Matsumoto by application of a mark on a belt side surface without inscription. Given these differences, combining the teachings of these two references, as proposed by the Examiner, without some incentive,

that has not been identified, is inappropriate. Absent impermissible use of hindsight with Appellant's invention in hand, there is nothing in these references that would necessarily motivate the modification of either of the references, in view of the other, to arrive at Appellant's claimed invention.

Reversal of the Examiner's rejection of claims 1, 4-7, 9-28 and 38-41 is respectfully requested.

Respectfully submitted,

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